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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,689	01/24/2001	Erich Harsch	82673-0005	3223

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EXAMINER

NGUYEN, JIMMY T

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,689

Applicant(s)

HARSCH ET AL.

Examiner

Jimmy T Nguyen

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/14/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 14, 2004 has been entered.

An action on the merits follows.

Specification

The disclosure is objected to because of the following informalities:

Page 1, line 14 and page 10, line 1 are objected to because they are improper to refer a claim in the specification. The specification is a stand alone document and is not read in light of the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-7 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 5, line 4, the specification does not support “the segment guides disposed on the disengageable cross member”. The specification discloses the segment guides disposed on the slide (page 7, lines 30-32).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, lines 4-6, it is unclear what is meant by “the transporting apparatus including a .. cross-member ... mounted to the transporting apparatus”.

Regarding claims 7, 9, 10, 12, and 13, the speculative terminology such as “can be” is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3725

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-4, 8-10 and 12, as best as can be understood, are rejected under 35

U.S.C. 102(b) as being anticipated by VanderZee et al. (US 5,979,212 – hereinafter “VanderZee”).

Regarding claims 2 and 10, VanderZee discloses an apparatus having a processing station (see fig. 1), wherein the processing station comprising: an independent transporting apparatus (42b), the independent transporting apparatus including a disengageable (fig. 11) cross-member (132) pivotable mounted (at section (380)) to a transporting element (238); and a sucker-cross member (268) movable mounted on the cross-member (see fig. 10), wherein a slide (276) is mounted in a linear guide (280), the linear guide positioned on the cross-member (fig. 10). The slide is movable in a horizontal direction (see col. 15, lines 53-62).

Regarding claim 3, VanderZee discloses the cross-member forms a universal joint (col. 16, line 18).

Regarding claim 4, VanderZee discloses a rod (272, 274) in operatively connected to the slide (fig. 10); a spindle/nut system (282) operatively connected to the rod; and a drive mechanism (284) for driving the spindle/nut system.

Regarding claim 8, VanderZee discloses the drive mechanism is operatively coupled to/joined the transporting apparatus via a spline shaft (290).

Regarding claim 9, VanderZee discloses the “spline” shaft can be displaced horizontally (via 244) in the transporting apparatus (see fig. 10).

Regarding claim 12, VanderZee discloses the sucker-cross member, the slide, the linear guide, and the rod can be driven jointly via the drive and the spindle nut system and can be fitted on both sides of the cross- member (fig. 14).

Allowable Subject Matter

Claims 5-7, 11 and 13 appear to have allowable subject matter and would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicants' arguments filed May 14, 2004 have been fully considered but they are not persuasive.

Applicants argue that the patent to VanderZee does not disclose an independent apparatus as illustrated in the Applicants' invention. With respect to Applicants assertions, this argument is not found persuasive because such independent apparatus as disclosed by Applicants is not clearly defined in the claim. The patent to VanderZee clearly anticipated the invention substantially as claimed as set forth above.

Further, applicants argue that VanderZee does not disclose the invention as recited in claim 1 (page 1, lines 5-12). This argument is not found persuasive because claim 1 has been cancelled, and all of the claims (2-13) do not claim such specific detail of the independent apparatus.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (703) 305-5304. The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on (703) 308-3136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTNguyen
June 24, 2004



**ALLEN OSTRAGER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**